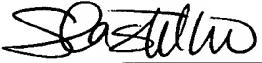


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re the application of: Meffezzoni)
Application No: 09/752,504) Group Art Unit: 2173
Filed: December 27, 2000) Examiner: Hailu, Tadesse
For: METHODS FOR MANAGING HOST) Atty. Docket No: ADAPP141
ADAPTER SETTINGS) Date: April 25, 2006

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450 on April 25, 2006.

Signed: 
Sylvia Castillo

PRE-APPEAL BRIEF – REQUEST FOR REVIEW

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Final Office Action of February 1, 2006, Applicant respectfully requests a pre-appeal review of the outstanding rejections in accordance with the Pre-Appeal Brief Conference Pilot Program announced on July 12, 2005 (1296 OG 67), which was extended on February 7, 2006 (1303 OG 21). In accordance with these procedures, Applicant respectfully submits that the present Application should be allowed for the reasons stated in the Remarks, which begin on the following page. This Pre-Appeal Brief is accompanied by a Notice of Appeal and required fee.

REMARKS

This Pre-Appeal Brief is submitted in response to the Final Office Action of February 1, 2006 (hereinafter “the Office Action”). All references herein to the claims, except as noted, will be made with reference to the claim list provided in the Amendment submitted November 11, 2005. References to line numbers in the Office Action, except as noted, will count every printed line, except the page header, but including section headings. If there is any confusion or questions regarding any aspect of this Amendment, the Examiner and other officials reviewing this Pre-Appeal Brief are invited to contact the undersigned.

For the purposes of this Pre-Appeal Brief, only the primary arguments are presented here. Additional arguments may be presented if and when the case proceeds to Appeal.

Summary

Applicant respectfully submits that the Office Action contains clear errors and that the Application should be allowed. Independent claims 1, 12, and 20 set forth method steps not described by the Symbios reference (“Symbios”) applied in the 35 U.S.C. § 102(b) rejection or suggested by the prior art applied in the 35 U.S.C. § 103(a) rejections. Specifically, claims 1, 12, and 20 set forth specific operations during rebooting and claim 12 additionally sets forth saving changes to adapter settings to a registry key, and reading the changes saved to the registry key during reboot. These elements are neither explicitly shown by Symbios, nor inherent thereto.

Claim Set 1 – Claims 1-11 and 35

Claims 1-3 and 8-10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Symbios, Inc., “PCI SCSI Device Management System SDMS 4.0 User’s Guide Version 7.0” (hereinafter, “Symbios”). Claim 1 includes, “rebooting the computer, the rebooting using code having program instructions for: locating the file having the changes, reading the changes saved to the file in the storage location, and writing the changes to a nonvolatile memory of the host adapter of the computer, wherein the reading and the writing are performed during the rebooting of the computer” (lines 9-16). Claims 9 and 11 provide that the system BIOS reads the changes saved to the file and writes the changes to the EEPROM of the host adapter, respectively. The Office Action identifies pages 34, 26, 24, and 27 as containing anticipatory language (Office Action, page 3, lines 9-14). Page 34 states that the

system must be rebooted for new settings to take effect. Page 26 states that the SCSI host adapters have NVRAM to used to store changes. Page 24 states that the system must be rebooted to take effect. Page 27 states that when “save” is selected in the user interface, the settings are saved to the NVRAM. The Examiner argues that since Symbios discloses a NTCONFIG Utility installed within Windows NT environment, the configuration changes are written to the non-volatile memory during system reboot (Office Action, page 12, lines 2-6). Applicant respectfully disagrees and suggests that the Examiner is reading into Symbios that which is not there for the purpose of meeting claim limitations.

A rejection based on anticipation requires that each and every element set forth in the claim be explicitly described by the reference, or else implicit or inherent to the reference. Applicant recognizes that express, implicit, and *inherent* disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. §§ 102 and 103. However, the fact that a certain result or characteristic *may* occur or be present in the prior art is *not sufficient* to establish the inherency of that result or characteristic. See MPEP 2112 IV. “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill’ (*In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981) (emphasis added).

The Office Action makes the assumption that, since the system must be rebooted for the settings to take effect, the steps of “locating the file having the changes, reading the changes saved to the file in the storage location, and writing the changes to a nonvolatile memory of the host adapter of the computer” must occur during the rebooting of the computer. However, it is also possible that the settings are stored directly into the nonvolatile memory of the host adapter at the time the changes are made. Just because the settings do not take effect until rebooting doesn’t mean that they cannot be stored directly into the nonvolatile memory of the host adapter. In fact, page 27 of Symbios states, “To save NVRAM data pertinent to the adapters via the NTCONFIG utility, select the Save choice.” This suggests that the data representing user selections is saved directly to the NVRAM at the time “Save” is selected.

Applicant respectfully submits that it would be incorrect to say that the feature of writing the changes to a nonvolatile memory of the host adapter during system reboot is

necessarily present in Symbios. Therefore, the feature cannot be considered inherent to Symbios, and therefore, not anticipated by Symbios.

With regard to claim 9, the Office Action states that the feature of the system BIOS reading the configuration changes is anticipated at “pages 29-30” of Symbios (Office Action, page 4, lines 13-14). However, with regard to system BIOS, Symbios only states that the BIOS will or will not issue a “SCSI Configured Automatically” (SCAM) negotiations during initialization based on the SCAM support adapter setting. SCAM is a well known plug-and-play protocol for automatically setting peripheral IDs. Applicant does not see any rational basis for suggesting that providing SCAM support meets the limitation of reading configuration changes as set forth in claim 9. With regard to claim 11, which stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Symbios and “Admitted Prior Art,” the Examiner suggests that it would have been obvious to provide a system BIOS that writes configuration changes to the EEPROM of a host adapter during system reboot in view of Symbios and Applicant’s “Admitted Prior Art.” Applicant respectfully submits that the Examiner is either reading into Symbios or misreading the background portion of the disclosure, from which the Admitted Prior Art is drawn. There is no suggestion in either document of a BIOS that writes data to the EEPROM of a host adapter during reboot. The Background section of the present Application states only that, during boot, the BIOS determines settings and initializes the computer in accordance therewith (page 3, lines 5-9).

Claim set 2 – claims 12-19 and 36

Independent claim 12 is rejected on the same grounds as claim 1. Accordingly Applicant respectfully refers to the discussion above for arguments against this rejection. Claim 12 additionally specifically mentions storing the settings in a registry key and reading the registry key during reboot. Specifically, claim 12 sets forth, “reading the changes saved to the registry key during the reboot operation” (lines 15-16) and “writing the changes to a nonvolatile memory of the host adapter of the computer during the reboot operation” (lines 17-18). The Office Action cites pages 13-15, 28-29, and 32 as containing anticipatory language. Applicant respectfully disagrees. Pages 13-14 of Symbios mention a specific registry key provided by Windows NT for enabling large transfer block sizes. This is not an adapter setting but an operating system setting. Symbios does not state (or even suggest) that this setting is read or copied to the host adapter during rebooting. As with many Windows settings, a system reboot is necessary for the setting to take effect (page 14, lines 7-8).

However, from this, it cannot be concluded that the setting is written to the host adapter (or anywhere else) during system reboot. As with Symbios' adapter configuration, it is possible as well as likely that the registry key settings are only read during boot up, so that changes made while the system is running do not take effect until the system is rebooted.

Claim set 3 – claims 20-23

Independent claim 20 contains limitations similar to those of independent claim 1. Applicant respectfully refers to the discussion above relating to claim 1 for arguments against claim 20.

Conclusion

In view of the foregoing, the Applicant respectfully submits that all of the pending claims are in condition for allowance. Applicant kindly requests that the Office withdraw the outstanding rejections and issue a Notice of Allowance. If the Office has any questions concerning the present Request, the undersigned can be reached at (408) 774-6933. If any additional fees are due in connection with filing this Request, the Commissioner is authorized to charge Deposit Account No. 50-0805 (Order No. LAM2P519). Enclosed herewith is the associated Notice of Appeal and Return Receipt Postcard.

Respectfully submitted,
MARTINE PENILLA & GENCARELLA, LLP


Leonard Heyman
Reg. No. 40,418

Martine Penilla & Gencarella, LLP
710 Lakeway Drive, Suite 200
Sunnyvale, California 94086
Tel: (408) 749-6900
Customer Number 25920